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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,816	02/05/2002	Nobuo Shiraishi	81833.0031	1572

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EXAMINER

HUYNH, LOUIS K

ART UNIT PAPER NUMBER

3721

DATE MAILED: 02/26/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,816

Applicant(s)

SHIRAISHI ET AL

Examiner

Louis K. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,6 and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,6 and 22-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose and/or teach a step of “cutting the mount on the plurality of concave portions to obtain a cut piece as a cosmetic material sheet.”

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 6, 22-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, lines 9-10: “and the pressed powdery cosmetic material forming a powdery cosmetic material adhering layer” is confusing because it is not understood as to how the pressed powdery cosmetic material forms a powdery cosmetic material adhering layer.

Claim 4, line 11: “the uppermost lamination material” lacks proper antecedent basis because there is only one lamination material has been set forth in the claim.

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Claim 4, line 12: "cutting the mount between or on the plurality of concave portions" renders the claim indefinite because it includes the step of cutting the mount on the plurality of concave portions which is not supported in the specification and would render the cut piece as an unusable cosmetic material sheet.

Claim 6, lines 11-12: "the uppermost lamination material" lacks proper antecedent basis because there is only one lamination material has been set forth in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 6, 22-29, 31, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muchin (US 5,161,688) in view of Gueret (US 4,962,627).

With respect to Claims 4 and 6, Muchin discloses a method and apparatus for manufacturing a cosmetic material sheet including: supplying a mount (52) having a plurality of concave portions (74) formed on an upper surface with suitable punch (59) (col. 5, lines 55-65); filling powdery cosmetic material (75) on the upper surface of the mount (52) with a filling device (squeegee-like tool 77); clearing the upper surface of the mount by removing a backing ply (56) along with any residue (79) with an inherent removing device (col. 6, lines 15-24; FIG. 3f); adhering lamination material (70) to the upper surface of the mount (52) with an inherent laminating device; and cutting the mount between the plurality of concave portions (74) (col. 6, lines 34-36; FIG. 3f) with a cutting tool (88) to obtain a cut piece (10) as a cosmetic material

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sheet. The method and apparatus of Muchin meet all of applicant's claimed subject matter but lack the specific teaching of a step of pressing the filled powdery cosmetic material and a pressing device for pressing the filled powdery cosmetic material.

However, powdery cosmetic material, such as makeup powder, are known to be sold in compact form, and Gueret discloses a method for producing cosmetic compact products from cosmetic powdery material wherein a quantity of cosmetic powdery material is pressed to form a compact product prior to being packaged.

Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the method of Muchin by having provided a pressing device for pressing the filled powdery cosmetic material, as taught by Gueret, in order to form a cosmetic sampler comprising cosmetic powdery material in a compact form that resemble the product to be sold.

With respect to Claims 22 and 26, the mount (52) is formed from plastic sheet (col. 2, lines 53-57).

With respect to Claim 23-25 and 27-29, the mount (52) disclosed in the Muchin reference includes any suitable material that can be formed into a plurality of cavities, and thermoplastic material such as polypropylene is one of such material. Therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have modified the method and apparatus of Muchin by having used polypropylene material for the mount as a matter of engineering design choice. Since applicant does not offer any advantage regarding the thickness of polypropylene material; therefore, it would have been obvious to an ordinary skilled

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person in the art as a matter of engineering design choice to have utilized polypropylene material having thickness of 100-200 μ m.

With respect to Claims 31 and 34, the squeegee-like tool (77) comprised the filling device in the modified apparatus of Muchin is considered to be equivalent to a brush; wherein the brush (77) is moved by an inherent moving means (FIG. 3e).

With respect to Claim 32, although not expressly disclosed, the modified apparatus of Muchin inherently includes a supply means for supplying the powdery cosmetic material (75).

7. Claims 30 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muchin (US 5,161,688) in view of Gueret (US 4,962,627) as applied to claim 6 above; and further in view of Matsos et al. (US 6,190,730).

With respect to Claim 30, the modified apparatus of Muchin meets all of applicant's claimed subject matter but lacks the specific teaching of the filling device comprising a printing plate. However, Matsos discloses an apparatus for screen printing powder-based cosmetic material including a screen printing press having a printing mesh and a squeegee for depositing the powder-based cosmetic material with desired shape and size on a film (4) (col. 2, lines 55-67). Therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have further modified the apparatus of Muchin by having provided a screen printing press, as taught by Matsos, in order to deposit the powdery cosmetic material with desired shape and size onto the mount.

With respect to Claims 33-36, the modified apparatus of Muchin would have included a printing mesh and a brush (squeegee) that comprise the filling device, wherein the printing mesh and the brush operate in a well known manner and are movable by inherent moving means for

moving the printing mesh and the brush toward and away from the mount that includes moving the printing mesh and the brush in an upward and downward direction.

Response to Arguments

Applicant's arguments with respect to claims 4 and 6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure has been cited on form PTO-892 along with the applied prior art.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

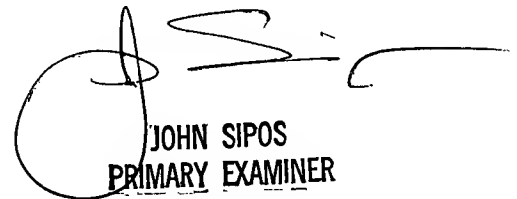
10. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (703) 306-5694. The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH
February 17, 2004



JOHN SIPOS
PRIMARY EXAMINER